



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Walter S. Miller, Sr.
8222 Douglas Avenue, Suite 777
Dallas, Texas 75225

MAILED

APR 03 2012

OFFICE OF PETITIONS

In re Patent No. 6,220,352 :
Issue Date: April 24, 2001 :
Application No. 09/157,427 : **ON PETITION**
Filed: September 21, 1998 :
For: PROCEDURE TO MOBILE :
ASPHALTENE-BASED CRUDE WITH A :
MICELLE SOLVENT :

This is a decision on the petition under 37 CFR 1.378(b), filed February 24, 2012, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent. This is also a decision on the petition to expedite under 37 CFR 1.182, filed March 20, 2012.

DECISION UNDER 37 CFR 1.182

In accordance with 37 CFR 1.182, “[a]ll situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).”

The petition under 37 CFR 1.182 filed March 20, 2012 requests that the petition under 37 CFR 1.378(b) filed February 24, 2012 be expedited. The general policy at the Office of Petitions at the USPTO is to treat petitions in the order in which they are filed. However, when able, the Office of Petitions will consider taking a petition out of order when such a petition under 37 CFR 1.182 is filed making such request.

In view thereof, the petition to expedite is hereby **GRANTED**.

Petitioner is advised that any future petitions filed in connection with the instant patent will be treated in keeping with currently Office of Petitions policy, i.e., the petition will be decided in the order in which it is filed.

DECISION UNDER 37 CFR 1.378(b)

The petition under 37 CFR 1.378(b) is **DISMISSED**.

The patent issued April 24, 2001. The 7.5 year maintenance fee could have been paid from April 24, 2008 through October 24, 2008, or with a surcharge during the period from October 25, 2008 through April 24, 2009. Accordingly, the patent expired April 24, 2009, for failure to timely submit the 7.5 year maintenance fee.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter.

A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

Petitioner herein asserts that he is the Managing Trustee of ETechMM and has included herewith a statement under 37 CFR 3.73(b).

Petitioner states that the delay in payment of the 7.5 year maintenance fee was unavoidable due to "the health decline, disability, and ultimate death of the previous Managing Trustee, James H. Coker. Mr. Coker died on September 24, 2011, and had been in a state of physical and mental incapacity for over 3 years prior to his death and not available for business decisions."

Petitioner further states that during Mr. Coker's incapacity, he "took all reasonable steps to conduct corporate business and to ensure timely payments were made. Such steps were thwarted due to the following:

1. Mr. Coker had the sole decision-making and financial responsibility and authority until his death,
2. Mr. Coker was not available or able to make business decisions, and
3. I was not able to serve as Managing Trustee until Mr. Coker's death. Following Mr. Coker's death, I assumed the duties of Successor Managing Trustee and worked to gain control of the ETechMM corporate records. I became aware of the expiration of the Patent on January 28, 2012 and since then I have worked diligently to obtain new legal counsel, review the files and then as promptly as possible to gain the information and forms necessary to file this petition. Therefore, the Applicant respectfully requests that this petition for re-instatement be granted."

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, petitioner must show that Mr. Croker was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due to Mr. Coker's medical conditions until the petition was filed.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by Mr. Croker or anyone else. In the absence of a showing that the Mr. Croker or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra. Put otherwise, the issues of Mr. Coker's health problems are immaterial in the absence of a showing that these, and not the lack of any steps in place to pay the fee, caused or contributed to the delay.

Petitioner asserts that Mr. Coker had the authority as managing trustee to pay the maintenance fee and that petitioner himself lacked the requisite authority to do so until he became managing trustee following the death of Mr. Croker. Unfortunately, any delay resulting from the actions or

inactions of Mr. Croker is binding. See, Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). While petitioner became managing trustee after the death of Mr. Croker on or about September 24, 2011, such merely gave petitioner the authority to file the instant petition on or after that date. That one may have subsequently exercised diligence after their assumption of title and belated awareness of the need to pay the fee does not convert the preceding delay into unavoidable delay. See Kim v. Quigg, 718 F.Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989).

Any renewed petition must establish that the entire period of delay from the time that the maintenance fee was due until the time of the filing of a grantable petition has been unavoidable. Petitioner is reminded that any renewed petition should entail an exhaustive effort to establish that the failure to timely pay the maintenance fee was unavoidable as after reconsideration pursuant to 37 CFR 1.378(e), no further reconsideration regarding unavoidable delay will be undertaken.

The record fails to establish that patentee took adequate steps to ensure timely payment of the maintenance fee as required by 37 CFR 1.378(b)(3). Since adequate steps were not taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee. Petitioner may request a refund of the surcharge and maintenance fee submitted with the instant petition by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By Hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Attorney Advisor
Office of Petitions